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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 01/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/904,102

Applicant(s)

LUU ET AL.

Examiner

Judy M. Reddick

Art Unit

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-- Th MAILING DATE of this communication app ars on the cov r sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 112-117 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 112-117 is/are rejected.
- 7) ☒ Claim(s) 112 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

#### **Claim Objections**

1. ***Claim 112 is objected to because of the following informalities: In claim 112 @ line 1, use of the indefinite article "a" should be inserted between "comprising" and "polyvinyl alcohol". Appropriate correction is required.***

#### **Double Patenting**

2. ***The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).***

***A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).***

***Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).***

3. ***Claims 112-117 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 26-31, 34 & 35 of copending Application No. 09/496,383 as per reasons stated in the previous Office Action per paper no. 8, 06/20/02. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.***

#### **Claim Rejections - 35 USC § 103**

4. ***The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:***

***(a) A patent may not be obtained though th invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the***

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***subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.***

***5. Claims 112– 117 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Smigo et al in combination with Hollenberg et al as per reasons of record per paper no. 8, 06/20/02. By the same token, Hollenberg et al teach the use of polymers containing functional groups such as hydroxyl groups, sulfate groups, active hydrogen-containing functional groups alone or mixtures thereof, as an operable component of the creping adhesive formulation(col. 3, lines 34-68 to col. 4, lines 1-15). To this end, the aforementioned polymers, although generic, necessarily imply that any polymer containing functional groups, including the claimed polyvinyl alcohol – vinyl amine copolymer, would have been operable within the scope of patentees invention and with a reasonable expectation of success. Moreover, following the guidelines of Smigo et al who teach the use of amine-functional polyvinyl alcohol polymers as conventional additives for enhancing the properties of paper-type products in similar such papermaking processes, it would have been obvious to the skilled artisan to use the polyvinyl alcohol/vinylamine copolymer of Smigo et al as the polymer containing a mixture of crosslinkable functional groups of Hollenberg et al and with a reasonable expectation of success. There is absolutely nothing viable on this record diffusing this issue.***

***Response to Arguments***

***6. Applicant's arguments filed 10/28/02 have been fully considered but they are not persuasive.***

**Relative to the Provisional Obviousness Type Double Patenting---Th D ubl**

***Patenting rejection is deemed proper and is sustained until an acceptable***

***Terminal Disclaimed has been filed.***

**Relative to Smigo et al/Hollenberg et al—It is urged and maintained that the**

***instantly claimed invention is obvious within the meaning of 35 USC 103 over the***

***prior art combination supra as per reasons of record.***

***Although counsel argues otherwise, it is prima facie obvious to combine two compositions, each of which is taught by the prior art to be useful for the same purposes(manufacture of paper-type products), in order to form a third***

***composition to be used for the very same purpose. The idea of combining them***

***flows logically from their having been individually taught in the prior art(In re***

***Kerkhoven, 626 F2d. 846, 850, 205 USPQ 1069). The fact that applicant has***

***recognized another advantage which would flow naturally from following the***

***suggestion of the prior art cannot be the basis for patentability when the***

***differences would otherwise be obvious(Ex parte Obiaya, 227 USPQ 58, 60).***

***As to the Declaration of inventor Phong Luu, such is an opinionated Declaration***

***from an interested party and is of little probative value. Counsel is herein apprised***

***that a composition and not a method is being claimed and to this end, the mixing***

***parameters would not apply, i.e., the manner in which the components are mixed***

***is immaterial . Moreover, the adhesive of Hollenberg et al is a creping***

***adhesive(see the Abstract).***

***Conclusion***

- 7. The additional prior art to Burnham et al(U.S. 2,577,840) listed on the attached FORM PTO 892 is cited as of interest in teaching the commonality of using zirconium***

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*compounds as x-linking agents for polyvinyl alcohol. The prior art to Aston et al (U.S. 5,246,548) is cited as of being illustrative of the general state of the art. The prior art to EP 337 310 is cited as of interest in teaching the use of cationic polymers such as poly(vinyl alcohol-vinyl amine) in papermaking processes. The prior art cited as of interest is considered to be merely cumulative to the prior art supra.*

**8. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

*A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.*

*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..*

*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.*

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*Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.*

*Judy M. Reddick*  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR *JMR*  
January 8, 2003